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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/772,649 | 02/04/2004 | Klaus Matheis | 696.023 | 5817 |
| 23598 | 7590 | 05/13/2005 | EXAMINER | |
| BOYLE FREDRICKSON NEWHOLM STEIN & GRATZ, S.C. 250 E. WISCONSIN AVENUE SUITE 1030 MILWAUKEE, WI 53202 | | | ADDISU, SARA | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3722 | |

DATE MAILED: 05/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) |
|------------------------------|-------------------------|---------------------|
| | 10/772,649 | MATHEIS, KLAUS |
| | Examiner Sara Addisu | Art Unit 3722 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 04 February 2004.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-35 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-3,5-7, 16, 21-25,27-30,34 and 35 is/are rejected.

7) Claim(s) 4,8-15,17-20,26 and 31-33 is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 04 February 2004 is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____

DETAILED ACTION

Specification

The use of the trademark Torx on Page 18, line7, has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Objections

Claim 3 is objected to because of the following informalities: The sentence starts with "he clamping". It should be "The clamping".

Claim 6 is objected to because of the following informalities: Third line of claim 6 cites "a actuation wedge". It should be "an actuation wedge".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5 and 23-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Comparing Claims 1, 23 and 30, claims 23 and 30 are written in dependant claim format but yet they repeat structure which was set forth in independent claim 1. It is not clear if claims 23 and 30 were meant to be dependant or independent claims. Claims 23 and 30 should clearly be amended to place in an independent or dependant format as desired.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, **Claim 5** recites the broad recitation 1-50 degrees, and the claim also recites 5-25 degrees, which is the

narrower statement of the range/limitation. Additionally claim 5, ends in semicolon.

Applicant should clarify whether or not there is missing information at the end of the claim.

Claim 16, lines 2-3 recites the limitation "adjustment wedge angle" and actuation wedge angle". There is insufficient antecedent basis for this limitation in the claim.

Claim 30 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Line 3 of claim 30 recites ".. particularly a tension screw". It is not clear as written of this is claimed or not.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 3, 6, 7, 21, 22, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Vig (U.S. Patent No. 4,602,899).

Vig teaches a cutting tool having a cutter plate (3), screw (17) for pressing the bottom of the insert against a support surface (13) of the tool as well as lateral wall sections (Col. 9, lines 47-55), springy pin (41), an adjustment wedging element (37) {arranged in a receptacle defines by guide edges (38 & 39)} which can be actuated and moved in longitudinal direction by means of a pressure screw (28), and stop surface

(35) forming the adjustable stop (15) for the cutting insert (Col. 10, lines 8-10 & Col. 12, lines 38-40) (see figures 1 and 2). Vig also teaches adjustment wedge being actuated as a result of set screw (28) being arranged to contact and slanted surface (34) of the actuating wedge (i.e. acting at an angle with respect to adjustment wedge surface) (see figure 2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23-25, 27, 28, 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vig (U.S. Patent No. 4,602,899), in view of Lindsay (U.S. Patent No. 4,592,680).

Vig teaches a cutting tool having an adjustment wedge as set forth in the above rejection.

However, Vig fails to teach a nut part.

Lindsay teaches a cutting tool having an insert retaining screw (32) including shank (34) that passes through slot (38) to engage locking member (nut part) (30) (See figure 1 and Col. 2, lines 18-25). Lindsay also teaches locking member (nut part) (30) being displaceable supported and received in a drill hole that extends at an angle (having components Ek, and Ef that are perpendicular to the lateral wall section) from

the outer circumference of the cutter support (12) (See figure 1 & 3). Regarding claims 28, 34 and 35, taking actual measurement of Es and Ek of Lindsay's diagram (figure 3), Es~ 4mm, Ek~14 mm giving a ration of 28.57%.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Vig's invention such that insert retention screw (17) has a locking member (nut part) as taught by Lindsay for the purpose of having precise retention of the insert at high rotational speeds since the resulting centrifugal forces cause increased tension in the locking screw ('680, Col. 1, lines 46-55 and 21-25).

Allowable Subject Matter

Claims 4, 8-15, 17-20, 26 and 31-33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara Addisu at (571) 272-6082. The examiner can normally be reached on 8:30 am - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Daniel W. Howell
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Art Unit 3722